

Claims 1-43 stand rejected under 35 U.S.C. §112, first paragraph, as containing new matter. Claims 1-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the San Francisco Examiner article (11/12/96) in view of www.beyondtherainbow2oz.com, further in view of the Packaging Week article (1997); the Atlanta Constitution article (3/30/99); Golub Russian Patent No. 2,111,908; the Forbes article (11/8/93); the Charlotte Observer article (3/4/93); the Seattle Times article (12/30/93); the Akron Beacon Journal article (11/11/92); the Star Tribune article (10/17/94); further in view of Newman, U.S. Patent No. 3,624,787, Beall, U.S. Patent No. 3,956,510 and Ruff, U.S. Patent No. 3,788,463. Applicant respectfully and vehemently traverses these rejections and requests that the rejections be withdrawn for the reasons set forth below.

The New Matter Rejection

Examiner takes the position that the amended claims referring to the "wad in direct contact with an inner surface of the container body" are not supported by the specification and, thus, this recitation in the claims constitutes new matter. Applicant respectfully submits that this rejection is in error for two equally compelling reasons and should be withdrawn.

First, the original disclosure clearly establishes the wad is in direct contact with the inner surface of the container body. In particular, Fig. 1A shows a wad of cotton candy and Figs. 1B, 2 and 3 show the wad positioned in the

container with the wad in direct contact with an inner surface of the container body as claimed.

The original specification on Page 9, lines 11-20 discloses positioning the wad of cotton candy "within a rigid container body". On Page 16, lines 10-14, reference is made to the light weight of the wad not, in itself, being sufficient to produce significant forces or stress on container body 20.

The fact that the application actually and specifically shows the wad in direct contact with the inside surface of the container clearly provides the necessary support in Applicant's disclosure for this recitation and, contrary to the Examiner's position, is not based on a position of silence as urged by Examiner.

Examiner argues that the cotton candy wad "could be" in transparent bags which may not be discernible in the figures. Applicant submits that this is in error since any plastic bag which would envelop the wad of cotton candy would clearly be evident in the figures. This is simply not the case here. The figures do not show any bag structure enveloping the cotton candy wad since Applicant's invention is directed to a wad of cotton candy positioned in a sealed container with the wad in direct contact with an inner surface of the container body as shown and claimed.

While this inventive feature was intended by the originally filed claims, as is apparent from Applicant's disclosure and the figures, Applicant incorporated this language in each of the independent claims to positively recite that the wad of

cotton candy is positioned in the container without any pre-packaging of the wad, such as being placed in a plastic bag, prior to the wad being positioned in the container and then the container sealed. This recitation is clearly supported by Applicant's disclosure and the figures.

Second, even if the application did not specifically, directly and expressly describe the direct contact of the cotton candy wad with the container's inner surface, the entire application makes such contact inherent through the noted specification above, and the entire description decrying the use of prior art plastic bags (see Page 4, line 1 through Page 7, line 23).

With respect to the doctrine of inherency, Section 2163.07(a) of the MPEP states:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 178 USPQ 279 (CCPA 1973).

Further, the Federal Circuit stated in *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ 2d 1227, 1232 (Fed. Cir. 2000):

The written description requirement does not require the applicant "to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of

ordinary skill in the art to recognize that [he or she] invented what is claimed."

Further on this point, "[i]f a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met." *In re Alton*, 37 USPQ 2d 1578, 1584 (Fed. Cir. 1996).

This is the case here as Applicant has merely claimed subject matter that is inherent from Applicant's disclosure. Nowhere in Applicant's specification does there appear any description whatsoever that the wad of cotton candy is pre-packaged in a bag prior to the wad being placed within the container and then the container sealed. In the specification and drawings, the container, and nothing else, contains, holds and protects the cotton candy wad. Examiner has failed to point to any express disclosure, or even a remote suggestion, in Applicant's disclosure that the present invention contemplates pre-packaging of the cotton candy wad in a plastic bag prior to the wad being positioned in the container and then the container sealed. As is evident from Applicant's disclosure, the Examiner's position is in error. Accordingly, Applicant requests that the rejections of claims 1-43 under 35 U.S.C. §112, first paragraph, be withdrawn.

The Section 103 Rejections

Examiner concedes, as he must, that the primary San Francisco Examiner article and secondary www.beyondtherainbow2oz.com website reference

are both completely silent with respect to positioning of a cotton candy wad in a container with the wad in direct contact with an inner surface of the container and the container sealed as claimed by Applicant. To overcome this deficiency in the rejection, Examiner appears to be taking the position that this claimed feature, while not expressly described in these prior art references, is inherent in the teachings of these references. This is error as a matter of law.

As the Federal Circuit has held in *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999):

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

As Examiner is aware, rejections must rest on a factual basis. *In re Warner*, 154 USPQ 173, 177-78 (CCPA 1967). To support such combination rejections as are here made, these facts must arise from the art, and not from 'doubts' of patentability, speculation, assumption or hindsight reconstruction to supply deficiencies in the factual basis. Without that suggestion from the art, the combination, and the rejection, must fail.

The Forbes, Charlotte Observer, Seattle Times, Akron Beacon Journal and Star Tribune articles applied by Examiner all disclose cotton candy in combination with a souvenir bucket, as similarly found in the San Francisco

Examiner article, and clearly fail to teach or suggest Applicant's claimed invention since each of these references is completely silent with respect to positioning the wad in a container with the wad in direct contact with an inner surface of the container and the container sealed as claimed by Applicant.

The Packaging Week and Atlanta Constitution articles each disclose cotton candy packaged in a bag and therefore do not teach or suggest Applicant's claimed invention when taken alone, or in combination with the other prior art of record. Golub discloses a transparent film which serves as packaging for a wad of cotton candy and relies on a needle to inject pressurized air into the thermoplastic bag to thereby protect the enclosed wad (see English translation of Golub at Page 6, lines 14-18, for example). Accordingly, Golub fails to teach or suggest a rigid, self-supporting container as claimed by Applicant.

Lastly, the Newman, Beall and Ruff references are each directed to a container for food or other type of product, and simply fail to teach or suggest when taken alone, or in combination with the other prior art of record, the combination of elements or method steps as claimed by Applicant. None deal with cotton candy, none deal with moisture degradation of cotton candy, none deal with compression damage to cotton candy and none provide any suggestion that any disclosure therein could be joined with the disclosures of the other prior art record.

Accordingly, the attempt by Examiner to establish a prima facie case of obviousness is incomplete and the rejections must fail.

Secondary Considerations

Notwithstanding Examiner's failure to establish a prima facie case of obviousness, Applicant submits herewith the Declaration of Daniel R. Kroeger, President and CEO of Gold Medal Products Company, assignee of the present invention, as further compelling evidence of non-obviousness of the present invention. Mr. Kroeger's Declaration sets forth compelling evidence of commercial success, long felt need, extensive copying of the claimed invention by others in the industry and accolades the present invention has received in the industry which must be considered and given due weight by Examiner. *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983). Mr Kroeger's Declaration also establishes the required nexus between the evidence set forth in the Declaration and the merits of the claimed invention.

In view of the above, Applicant respectfully submits that claims 1-43 are allowable and the rejections should be withdrawn. Reconsideration and allowance of the present application is respectfully requested.

Conclusion


In view of the foregoing response including the remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be resolved by telephone conference, the Examiner is invited to contact the

undersigned in order to resolve the same and expedite the allowance of this application.

Attached is a check in the amount of \$210.00 for the two months extension fee as set forth in 37 C.F.R. § 1.136(a). If any other fees are deemed necessary to complete this Communication, these may be charged to Deposit Account No. 23-3000.

Respectfully submitted,

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